



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,197	03/25/2004	Paul Wei	1055-D3734	5995
34456	7590	04/04/2006		
LARSON NEWMAN ABEL POLANSKY & WHITE, LLPL.L.P. 5914 WEST COURTYARD DRIVE SUITE 200 AUSTIN, TX 78746			EXAMINER MARCHESCHI, MICHAEL A	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/809,197

Applicant(s)

WEI ET AL.

Examiner

Michael A. Marcheschi

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 23-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicants have not properly responded to the restriction, thus this restriction is made final.

Claims 1-22 are rejected under 35 U.S.C. 103(a) as obvious over Wei et al. (724) alone or in view of Abrahamson and Christianson for the same reasons set forth in the previous office action which are incorporated herein by reference. To address the amended limitations, the teachings in column 2, lines 60-63 and column 3, lines 40-55 of Wei et al. read on these limitations.

Applicant's arguments filed 1/13/06 have been fully considered but they are not persuasive..

In parts I, II, and III of section 2 of the response, applicants argue that the examples show evidence of unexpected results with respect to the use of a thermally curable resin in powder form. This is not persuasive because the examples are not commensurate in scope with the claims (i.e. examples are directed to specific formulations which are much narrower than the formulation claimed). The second reason the argument is not persuasive is because it is the examiner position that the amount of all components (and not the use of a powder binder itself) can vary the performance characteristics and applicants have not shown otherwise (i.e. that the powder component alone, in any formulation, including any amounts of the other components, will provide the same results in any and all formulations). In other words, is the powder component by itself responsible for the change in abrasive performance (i.e. performance is not dependent on the composition as a whole but only on the use of a powder component)? Finally,

Art Unit: 1755

the third reason the argument is not persuasive is because the examples compare specific abrasive formulations that contain a specific thermoset resin in powder form with controls that do not contain a thermoset resin (irrespective of the forms). The primary reference clearly teaches that a mixture of radiation curable and thermally curable resin are used as the binder. Since a thermally curable binder is clearly used in the reference, the examples in the instant specification do not compare the claimed invention with that of the reference teachings (i.e. all of the instant examples do not contain any thermally curable resin and thus do not show evidence of criticality for the powder forms when compared to the liquid form). The controls are not consistent with the teachings of the reference applied

In part IV of section 2, applicants states that they confirm that the radiation curable binder utilized in the reference is in liquid form. The examiner is unclear as to this remark because the claimed invention does not define the form of radiation curable resin. Assuming that applicants meant “thermally curable resin” instead, a mere statement without a declaration to support this does not clearly and persuasively establish applicants position. However, the use of a powder binder is obvious as defined in the previous office action. Any argument based on this obviousness determination will be addressed in the next paragraph.

In part V of section 2, applicants appear to argue that even though Abrahamson is representative of thermally curable powders, the teaching are limited to the use of these powders in bonded abrasives and not coated abrasives. Even though applicants position is well taken, it is the examiners position that the skilled artisan would have readily appreciated the concept of using binders interchangeably in bonded abrasives and coated abrasives because this reference, in column 10, line 41-column 11, line 20 and column 11, lines 64-68, clearly shows that coated

Art Unit: 1755

abrasives can be made, as well, by the use of conventional organic binder (phenolic resin-i.e. this is the same resin used in column 3, lines 27-28). To further support the examiners position, reference is drawn to column 4, lines 40-43 of Christianson where it is clearly suggested that the same binder can be used to adhere abrasives together (i.e. bonded abrasive) or bond the abrasives to a backing (coated abrasives). Again applicants state that they have discovered improvements relating to coated abrasive when a powder binder is used. Since the results are not commensurate in scope with the claims and do not compare the claimed invention to the reference composition (i.e. the reference clearly contains a thermally curable binder and applicants results are based on a comparison of a formulation absent any thermally curable binder), no clear showing of criticality for the use of a powder in the claimed broad abrasive formulations is established. In other words, applicants have not shown that a product made from a powder binder produces unexpected results over a product made from a liquid binder.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 1755

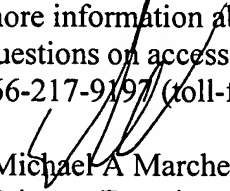
however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

3/06
MM


Michael A Marcheschi
Primary Examiner
Art Unit 1755